REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of September 18, 2008 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 50-0951.

Although Applicants respectfully disagree with the rejections, Applicants have amended Claim 1 and cancelled Claims 11-15, 18, and 20-21. Also, Applicants have submitted new Claims 26-37. However, Applicants are not conceding that the cancelled claims fail to present patentable subject matter. The cancellations are solely for the purpose of expediting prosecution. Accordingly, the cancellations should not be interpreted as the surrender of any subject matter, and Applicants expressly reserve the right to present the original version of any of the cancelled claims in any future divisional or continuation applications from the present applications. No new matter has been introduced by this amendment.

Aspects of Applicants' Invention

It may be helpful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, as illustrated by amended Claim 1, is an instant messaging method. The method can include displaying a user selectable list of subscribers in a graphical user interface of an instant messaging service. The method can also include selecting a group of subscribers in an inactive state from the list in the graphical user interface. Furthermore, the method can include designating at least one action associated with the group via the graphical user interface, the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change; automatically detecting a state change of at least one of said subscribers in said group; and, automatically executing said

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designated action associated with said group for said at least one subscriber responsive to said detecting step. (See, e.g., Specification, paragraphs [0038]-[0039], and FIGS. 1-2)

Claim Rejections – 35 USC § 103

In the Office Action, Claims 1-4, 8, 10-14, 18, 20, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,691,162 to Wick (hereinafter Wick) in view of U.S. Patent 7,266,776 to Quillen, *et al.* (hereinafter Quillen). Claims 5 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wick in view Quillen, and in further view of U.S. Patent 6,430,604 to Ogle, *et al.* (hereinafter Ogle).

Although Applicants respectfully disagree with the rejections, Applicants have amended Claim 1 and cancelled Claims 11-15, 18, and 20-21 in the interest of expediting prosecution.

Considering amended Claim 1, Quillen fails to disclose an instant messaging method for selecting or designating at least one action associated with a group of subscribers *via the graphical user interface of an instant messaging service.* Instead, Quillen explicitly teaches using an icon to facilitate network communications between users of at least one communications program. (Col. 2, lines 65-67, Col. 3, lines 1-20). Rather than designating at least one action associated with a group via the graphical user interface of the instant messaging service, Quillen designates actions through an icon, which is *independent* of a communication program's user interface. (Col. 2, lines 65-67, Col. 3, lines 1-20).

Quillen specifically states:

> "The icon provides an interface for initiating actions related to the identity or set of identities from outside of a communication application user interface. The actions are initiated by performing operations on the icon. Such operations may generally include, for example, "double-clicking" on the icon, "right-clicking" on the icon, or dragging and dropping files onto the icon." (Col. 3, lines 3-9).

Accordingly, Quillen fails to allow the display and selection of a group of subscribers in an inactive state through the graphical user interface of an instant messaging service. By relying on an icon that is independent from a communication application user interface, Quillen further fails to designate at least one action associated with the group via the graphical user interface of an instant messaging service. As both Wick and Quillen fail to disclose selecting a *group of subscribers* within a list via a graphical user interface of an instant messaging service, designating at least one action with the *group* via the graphical user interface, or automatically executing a designated action associated with the *group*, it would not have been obvious to one of ordinary skill in the art to include these features in Applicants' invention based upon Quillen and Wick.

Considering new independent Claim 29, neither Quillen nor Wick explicitly discloses selecting a group of subscribers in an inactive state from a list or designating an action associated with the group, wherein the inactive state comprises at least one among an offline state, a do-not-disturb state, an away-from-desk state, an out-of-office state, an inactive state resulting from an inactive state change, and a state where an instant messaging session cannot be established with a subscriber. (See, e.g., Specification, paragraphs [0033] and [0036]). When referring to setting an alert for possible status changes, Quillen merely lists a login, a logout, and an idle state as possible states. (Col 3, lines 12-13). Similarly, the inactive state that Wick allows a pounce for is only a pouncee's signing on to the system. (Col. 5, lines 13-15, lines 35-36, and FIG. 8). Accordingly, Quillen and Wick fail to designate actions for a group of subscribers for the inactive states the present invention provides.

Accordingly, Quillen and Wick, alone or in combination, fail to teach or suggest every feature recited in independent Claim 1, as amended, or new independent Claim 29. Ogle, which is relied upon by the Office Action for its inclusion of a Lotus Sametime

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(TM) type client, does not make up for the deficiencies of Quillen and Wick as discussed above. Applicants respectfully submit, therefore, that amended Claim 1 and new Claim 29 define over the prior art. Applicants further respectfully submit that, since claims 2-5, 8, 10, and 26-28 depend from Claim 1 and claims 30-37 depend from Claim 29, these dependent claims likewise define over the prior art.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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